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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/041,835

10/25/2001

Jay S. Dweck

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09/30/2005

BUCKLEY, MASCHOFF, TALWALKAR LLC
5 ELM STREET
NEW CANAAN, CT 06840

EXAMINER

DENNISON, JERRY B

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,835

Applicant(s)

DWECK, JAY S.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/25/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to Application Number 10/041,835 received on 25 October 2001.
2. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 91 is directed to a computer-readable medium that stores data accessible by a program to perform a method, in which the computer-readable medium may be directed towards a floppy disk, CD-Rom (see Specification, page 14 last paragraph), and is therefore not tangibly embodied in a manner so as to be executable and is thus non-statutory for failing to be in one of the categories of invention.

Examiner Remarks

4. Before a detailed rejection of the claims, Examiner would like to discuss the term non-reciprocal communication. In Applicant's Specification, the term non-reciprocal communication is a mode of communication that only allows for communication in a single direction (see Specification, page 2, lines 1-5). Applicant continues on with reference to America Online, stating that it does not allow non-reciprocal communication

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because it requires that both the sender and the intended recipient to be on-line at the same time to initiate an IM discussion (see Specification, page 2, lines 14-20). One of Applicant's suggested benefits of the present invention is that it allows non-reciprocal communications over computer networks (see Specification, page 3, lines 8-14).

Examiner does not see this novelty presented in the claimed invention. Examiner does not see anywhere in the claims where the relationship of on-line status and initiating IM discussions exists. Nowhere in the claims does it say that a sender may initiate a communication session even if the receiver is not currently online, or anything remotely close to this functionality. The claimed invention does not include anything about the online status of any participants at all. If Applicant decides to amend claims, Examiner suggests researching other instant messaging programs, such as ICQ and Yahoo Messenger.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA).

5. Regarding claims 1, 9, 13, 15, 20, and 21, AAPA disclosed a network communication method, comprising:

identifying, for a communication session, an originator and a participant;
establishing a reciprocity rule for said communication session;
and conducting said communication session involving said originator and said participant based on said reciprocity rule (AAPA, Spec, page 2, AAPA admitted IM services offered by America Online in which a session is started between a sender and intended recipients using reciprocal communication).

Claim 9 includes a communication device including limitations that are substantially similar to those of claim 1, and are therefore rejected under the same reasoning. Claim 13 further includes a communications port in order to communicate with a messaging server or a participant. It is inherent that the sending device of a sender using America Online includes a port to provide communication to the America Online Server as well as a participant and therefore claim 13 is also rejected under the same reasoning as claim 1. Claim 15 includes a messaging system including limitations that are substantially similar to those of claim 1, and are therefore rejected under the same reasoning.

6. Regarding claim 2, AAPA disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said identifying further comprises identifying a plurality of participants and wherein said conducting further comprises involving said plurality of participants (AAPA, Spec, page 2, AAPA admitted users of America Online

having a chat rooms in which a sender may communication with a plurality of recipients).

7. Regarding claim 3, AAPA disclosed the limitations, substantially as claimed, as described in claim 2, including establishing a plurality of reciprocity rules (AAPA, Spec, page 2, AAPA admitted the types of networks admitted require reciprocity in transmissions).

8. Regarding claims 4 and 14, AAPA disclosed the limitations, substantially as claimed, as described in claims 1 and 9, including wherein said identifying further comprises: selecting said participant from an address book (AAPA, Spec, page 2, AAPA admitted senders of America Online selecting from a Buddy List).

9. Regarding claims 5, 6, 8, 10- 12, and 16-18, AAPA disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 15. The issues left out of AAPA are the reciprocity rule either preventing or permitting said participant from sending a response message to said originator and the ability to modify said reciprocity rule during said communication session. Examiner takes Official Notice (see MPEP § 2144.03) that "permitting or blocking recipients in responding to the originator as well as being able to modify the reciprocity rule during said communication" in an instant messaging environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according

to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

10. It is suggested by Examiner that Applicant review the following related art: Davies et al. (U.S. Patent Number 6,853,634) in which Davies disclosed that users of the ICQ instant messaging system are able to control who contacts them and to hide their presence on the internet when required (Davies, col. 2, lines 40-45). This clearly shows that the sender has the ability to permit or prevent recipients from responding as well as the sender being able to modify the rules during the communication when necessary.

11. Regarding claim 7, AAPA disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said communication session is an Internet

instant messenger session (AAPA, Spec, page 2, AAPA admitted America Online providing instant messenger services).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Paglin (U.S. Patent Number 6,393,421).


Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

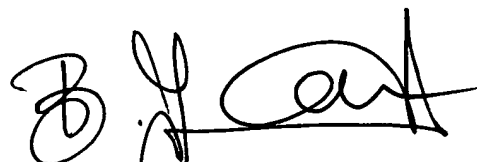
In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


J. B. D.
Patent Examiner
Art Unit 2143


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PRIMARY EXAMINER